

### Remarks

The claims were amended in accordance with the amendments above. The amendments to the claims are being made merely to clarify the invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

As an initial matter, Applicant notes that the recited “display screens” is intended to include a variety of types of displays, and that it is not intended that the recited “display screens” or other recited displays be limited to LED displays unless explicitly claimed as such. Applicant further notes that this contemplation is evidenced by Applicant’s suggestion to use various image/video formats at p. 13, lines 19-24 of the present specification; and Applicants’ incorporation by reference (at p. 21, ll. 1-4 of the present specification) of U.S. Patent No. 5,724,062, which discloses several types of displays at Col. 1, ll. 18-32, among other places. Accordingly, to the extent that Applicant has previously argued during prosecution of related applications that the invention claimed in those applications was directed to LED displays, Applicant expressly notes that the invention claimed herein includes many other types of displays in addition to LED displays. Applicant further expressly disclaims herein any reliance on distinctions and arguments previously made regarding LED displays relative to the prior art. Accordingly, the term “display screen” or “display screens,” as recited in the present or future claims, should be interpreted as broadly as reasonably permitted by the disclosure, and not with regard to any argument or claim amendment made in related applications. Furthermore, while Applicant has cited portions of the specification evidencing contemplation of various types of display devices, Applicant does not intend for the terms “display screen” or “display screens” to be necessarily limited to such examples.

### §102 Rejections

In the Office Action dated 01/25/2008, claims 1-2 and 6 were rejected under 35 U.S.C. §102(e) as being unpatentable over Carney (U.S. 6,408,278). Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as

complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Applicant submits that Carney fails to teach or suggest all of the limitations recited in amended independent claim 1, particularly in the arrangement required by the claim. For instance, amended independent claim 1 recites “a means permitting merchants to select particular display screens for placement of advertisements.” Carney fails to teach or suggest such limitations, among others, particularly in the arrangement required by claim 1. To the contrary, Carney teaches that the system itself selects particular display screens for placement of advertisements, based on desired demographic information and other information submitted by a user. See Col. 8, l. 66 through Col. 9, l. 5. Accordingly, Carney fails to anticipate claim 1 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Amended independent claim 6 recites “permitting a participating merchant to place video or still-image advertisements at selected times on display screens selected by the merchant.” Carney fails to teach or suggest such limitations, among others, particularly in the arrangement required by amended claim 6. As noted above with respect to the rejection of claim 1, Carney teaches that the system itself, not the merchant, that selects the display screens. See Col. 8, l. 66 through Col. 9, l. 5. Accordingly, Carney fails to anticipate amended claim 6 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty.

### §103 Rejections

Claims 3-5 and 7 were rejected under 35 U.S.C. §103(a) as being obvious over Carney. Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the Office must give due consideration to all of the limitations of a claim. The Office must also sufficiently establish a motivation to combine or modify the teachings of the prior art in order to reach a claimed invention in accordance with MPEP 2143.01. Obviousness rejections “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International*

*Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of the present claims obvious.

As noted above with respect to the §102 rejections, Carney fails to teach all of the limitations of amended claim 1. The Office has not cited any other prior art reference that makes up for such deficiency of Carney. The combined art of record therefore fails to render amended claim 1 obvious in accordance with MPEP 2143.01. Furthermore, the Office has not provided articulated reasoning with some rational underpinning, beyond merely conclusory assertions, that would support an obviousness rejection of amended claim 1 in accordance with MPEP 2143.03. Because claims 3-5 depend from amended claim 1, and include additional limitations, the combined art of record also fails to render any of claims 3-5 obvious in accordance with MPEP 2143. Applicant therefore respectfully requests that the rejections be withdrawn.

Similarly, the Office has not cited any prior art reference that makes up for the deficiency of Carney noted above with respect to amended claim 6. The combined art of record therefore fails to render amended claim 6 obvious in accordance with MPEP 2143.01. Furthermore, the Office has not provided articulated reasoning with some rational underpinning, beyond merely conclusory assertions, that would support an obviousness rejection of amended claim 6 in accordance with MPEP 2143.03. Because claim 7 depends from amended claim 6, and includes additional limitations, the combined art of record also fails to render claim 7 obvious in accordance with MPEP 2143. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

### Conclusion

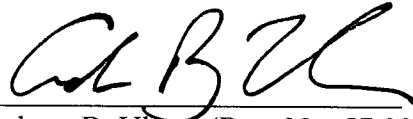
While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an

admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513)369-4811 or via e-mail at [aulmer@fbtlaw.com](mailto:aulmer@fbtlaw.com).

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'A B Ulmer', is written over a horizontal line.

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